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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/470,058	12/22/1999	KIMBERLY JOYCE WELBORN		5713
41212	7590	08/09/2004		
NORMAN KEN OUCHI P.O. BOX 20111 SAN JOSE, CA 95160				
			EXAMINER NOBAHAR, ABDULHAKIM	
			ART UNIT 2132	PAPER NUMBER

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/470,058

Applicant(s)

WELBORN ET AL.

Examiner

Abdulahkim Nobahar

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 18-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18,20-22,26,28-31,34 and 35 is/are rejected.
- 7) ☒ Claim(s) 19,23-25,27,32-33,36 and 37 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Response to Arguments***

1. This communication is in response to applicant's Response received on May 20, 2004.
2. Claims 1-17 are cancelled.
3. Claims 18-34 are newly added and no new matter is introduced.
4. In view of new grounds of rejection the claims rejection are as follows.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21 and 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claims 21 and 31, there is no explanation in the specification on the following:

Claim 21: "a second list of e-mail user identifiers is created..."

Claim 31: "the e-mail user identifier is added to a second list..."

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18, 22, 26, 30 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Venkatraman et al. (6,014,688) (hereinafter Venkatraman).

Regarding claim 18, Venkatraman discloses:

A computer virus avoidance system that sends an e-mail with a mock computer virus to e-mail users (see, for example, column 1, lines 15-19 and column 4, lines 3-7) and creates a first list of e-mail user identifiers of e-mail users who activate the mock computer virus. See, for example, column 5, lines 3-10, column 6, lines 10-15, column 8, lines 1-23, column 8, lines 32-42 and Fig. 15, where collecting and compiling the

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return receipt responses corresponds to the recited "creates a first list of e-mail user identifiers..."

Regarding claim 22, Venkatraman discloses:

The mock computer virus sends e-mail to a preset e-mail address when the mock computer virus is activated (see, for example, column 2, lines 34-37, Fig. 15, 160 and column 8, lines 37-43).

Regarding claim 26, Venkatraman discloses:

E-mail with the mock computer virus is sent to an e-mail user (see, for example, column 1, lines 15-19 and column 4, lines 3-7) and when the e-mail user activates the mock computer virus, the e-mail user identifier is added to a first list. See, for example, column 5, lines 3-10, column 6, lines 10-15, column 8, lines 1-23, column 8, lines 32-42 and Fig. 15, where collecting and compiling the return receipt responses corresponds to the recited "the e-mail user identifier is added to a first list."

Regarding claim 30, Venkatraman discloses:

The mock computer virus sends e-mail to a preset e-mail address when the mock computer virus is activated (see, for example, column 2, lines 34-37, Fig. 15, 160 and column 8, lines 37-43).

Regarding claim 34, Venkatraman discloses:

An e-mail with the mock computer virus is sent to an e-mail user (see, for example, column 1, lines 15-19 and column 4, lines 3-7) and when the e-mail user activates the mock computer virus, the identifier of the e-mail user is added to the list of e-mail user identifiers of e-mail users that activate a mock computer virus. See, for example, column 5, lines 3-10, column 6, lines 10-15, column 8, lines 1-23, column 8, lines 32-42 and Fig. 15, where collecting and compiling the return receipt responses corresponds to the recited "the identifier of the e-mail user is added to the list..."

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20, 28 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Venkatraman et al. (6,014,688) (hereinafter Venkatraman) in view of Donoho et al. (6,256,664 131) (hereinafter Donoho).

Regarding claims 20, 28 and 35, Venkatraman does not expressly disclose that an e-mail message is sent to the user who activates the mock computer virus (opens the attachment of an e-mail). Donoho (column 88, lines 13-35) teaches a method of broadcasting advisory messages to a plurality of information consumers. In this method

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the mail reader application located on the consumer computer sends a notifying message to advisory reader upon occurrence of an event corresponding to the recited "open the attachment". The advisory reader evaluates the advisories in an event pool upon receiving the notifying message and sends a relevant message(s) to the mail reader and the mail reader then displays the message(s) to the user who has opened the attachment.

It would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to incorporate the feature of sending (advisory or warning) message(s) to user who opens an e-mail attachment as taught in Donoho in the system of Venkatraman, because it would provide a mechanism to direct typical piece of information to consumers having a very special combination of circumstances (column 1, lines 33-35).

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Venkatraman et al. (6,014,688) (hereinafter Venkatraman) in view of Fischer (5,390,247).

Regarding claim 29, Venkatraman does not expressly disclose that the e-mail attachment at the recipient computer transmit itself to other e-mail users, if the user activates the attachment (the mock computer virus). Fischer discloses a method for creating a traveling program that is capable of determining at least one next recipient and transmitting itself to that recipient(s) automatically. See, for example, abstract, column 5, lines 37-42 and column 7, lines 46-57.



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It would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to incorporate the capability of transmitting itself to other recipients by a computer code as taught in Fischer in the system of Venkatraman, because it would provide a feature for the e-mail attachment to determine at least one next destination or recipient for transmitting itself (column 5, lines 1-7).

### ***Allowable Subject Matter***

Claims 19, 23-25, 27, 32, 33, 36 and 37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

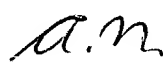
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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdulhakim Nobahar whose telephone number is 703-305-8074. The examiner can normally be reached on M-F 8-5.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 703-305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Abdulhakim Nobahar  
Examiner  
Art Unit 2132

AN

August 2, 2004

  
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